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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/669,899	09/27/2000	Makiko Endo	35.C14832	4427

5514 7590 04/26/2002

FITZPATRICK CELLA HARPER & SCINTO
30 ROCKEFELLER PLAZA
NEW YORK, NY 10112

EXAMINER

SHOSHO, CALLIE E

ART UNIT	PAPER NUMBER
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1714

9

DATE MAILED: 04/26/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/669,899

Examiner

Callie E. Shosho

Applicant(s)

ENDO ET AL.

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AS-9

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. All outstanding rejections except for those described below are overcome by applicants' amendment filed 2/11/02.

Claim Rejections - 35 USC § 102

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claims 1, 5-11, and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by EP 732381.

The rejection is adequately set forth in paragraph 4 of the office action mailed 9/11/01, Paper No. 7, and is incorporated here by reference.

4. Claims 1-4, 6, and 11-15 are rejected under 35 U.S.C. 102(b) as being anticipated by EP 130789.

The rejection is adequately set forth in paragraph 5 of the office action mailed 9/11/01, Paper No. 7, and is incorporated here by reference.

5. Claims 1, 6-11, and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Banning et al. (U.S. 5,700,851).

The rejection is adequately set forth in paragraph 6 of the office action mailed 9/11/01, Paper No. 7, and is incorporated here by reference.

6. Claims 1, 5-11, and 15 are rejected under 35 U.S.C. 102(e) as being anticipated by Hodge (U.S. 5,985,988).

The rejection is adequately set forth in paragraph 8 of the office action mailed 9/11/01, Paper No. 7, and is incorporated here by reference.

Claim Rejections - 35 USC § 103

7. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

8. Claims 2-4 and 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 732381 or Banning et al. (U.S. 5,700,851) either of which in view of either JP 11228655 or EP 130789.

The rejection is adequately set forth in paragraph 11 of the office action mailed 9/11/01, Paper No. 7, and is incorporated here by reference.

9. Claims 2-4 and 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hodge (U.S. 5,985,988) in view of EP 130789.

The rejection is adequately set forth in paragraph 12 of the office action mailed 9/11/01, Paper No. 7, and is incorporated here by reference.

Response to Arguments

10. Applicants arguments with respect to Micale (U.S. 4,665,107) have been considered but they are moot in view of the discontinuation of this reference against the present claims.

11. Applicants arguments filed 2/11/02 have been fully considered but they are not persuasive.

Specifically, applicants argue that none of the cited references disclose a colored resin comprising a colorant dispersed in a macromolecular state in the resin.

With respect to EP 130789, it is noted that page 19, lines 16-21 discloses that the colored polymer is produced by adding dye to an aqueous polymer solution and then stirring the mixture under heat to form the colored polymer. Given that this is the exact method used to produce the colored resin in the present invention (see page 11, line 24-page 12, line 2 of the present specification), applicants' argument that EP 130789 does not disclose colored resin as presently claimed is not understood. Further, applicants offer no evidence or explanation to support their position. Thus, it is the examiner's position that, absent clear and convincing evidence to the contrary, the colored polymer disclosed in EP 130789 is identical to that presently claimed.

With respect to EP 732381, it is noted that page 9, line 57-page 10, line 2, disclose that the colorant is incorporated into the polyol which is used to produce the polyurethane. Page 10, lines 19-26 of the present specification define the colorant dispersed in the macromolecular state as the condition wherein the colorant is incorporated into the network structure of the resin. Given that EP 732381 discloses that the colorant is incorporated into the polyol, which is used to form the polyurethane, it would necessarily follow that the colorant is, therefore, incorporated

into the network structure of the polyurethane. Similar arguments are made with respect to Banning et al. Namely, given that Banning et al. disclose producing polyurethane from the reaction product which includes colorant, it would be natural for one of ordinary skill in the art to infer that the colorant is incorporated into the polyurethane structure and thus meets the requirements of the present claims that the colorant is dispersed in the monomolecular state in the film-forming resin, i.e. the polyurethane. Applicants argue that neither EP 732381 nor Banning et al. disclose colored resin as presently claimed, but do not provide any evidence or explanation to support their position that the colored polymers of EP 732381 or Banning et al. do not meet the requirements of the present claims. Clarification is requested.

With respect to Hodge, applicants argue that the method of coloring the polyester is different than that used in the present invention and does not always produce a resin comprising colorant dispersed in the monomolecular state as presently claimed. However, it is noted that page 12, lines 19-20 of the present specification discloses that coloration of the resin is not limited to one method. Further, while applicants argue that the method does "not always" produce the claimed colorant, this clearly indicates that in some instances, the method can produce the presently claimed colorant, and thus, Hodge does meet the requirements of the present claims.

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Callie E. Shosho whose telephone number is 703-305-0208. The examiner can normally be reached on Monday-Friday (6:30-4:00) Alternate Fridays Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 703-306-2777. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

CS

Callie Shosho
April 25, 2002

Vasu Jagannathan
VASU JAGANNATHAN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700